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Date: August 22, 2006	Phone Number	Fax Number
To: Examiner Simitoski		(571) 273-8300
From: Kevin J. Zilka		

Docket No.: NAI1P458/00.164.01

App. No: 09/809, 073

Total Number of Pages Being Transmitted, Including Cover Sheet: 11

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being facsimil transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 to fax number (571) 273-8300		Application Number	Filed
on August 22, 2006		09/809,073	03/16/2001
Signature <u>April Skovmand</u>		First Named Inventor	
Typed or printed name April Skovmand		Lee Codel Lawson Tarbotton	
		Art Unit	Examiner
		2134	M. Simitoski
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature	
<input type="checkbox"/>	applicant/inventor.	Kevin J. Zilka	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/86)	Typed or printed name	
<input checked="" type="checkbox"/>	attorney or agent of record. 41,429	408-971-2573	
Registration number		Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34.	August 22, 2006	
Registration number if acting under 37 CFR 1.34		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/>	Total of 1 forms are submitted.		

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REMARKS

The Examiner has rejected Claim 44 under 35 U.S.C. 112, as being indefinite. Applicant respectfully disagrees, since the "at least one" language is not inconsistent with the claimed plural games and programs, etc.

The Examiner has rejected Claims 1, 4, 7, 13, 15, 18, 21, 27, 29, 32, 35, 41, and 45 under 35 U.S.C. 102(b) as being anticipated by Kephart (U.S. Patent No. 5,452,442). Applicant respectfully disagrees with such rejection.

With respect to the independent claims, the Examiner has relied upon an inherency argument with respect to the Kephart reference to make a prior art showing of applicant's claimed technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (see this or similar, but not necessarily identical language in the independent claims).

In response, applicant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Specifically, applicant respectfully asserts that Col. 5, lines 57-61 from Kephart merely discloses that "the user supplies either (a) a file containing a list of virus signatures to be evaluated or (b) one or more files, each containing one or more portions of invariant viral code from which one or more virus signatures are to be extracted" (emphasis added).

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Clearly, Kephart's disclosure of using one or more portions of invariant viral code to extract virus signatures fails to even suggest a technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (emphasis added), as claimed by applicant.

In addition, applicant respectfully asserts that Kephart discloses that "[i]n the evaluation mode the procedure starts with a given list of candidate signatures, one or more for each virus" (emphasis added). Kephart further discloses that "the invention has been described above in the context of methods and apparatus for evaluating and extracting signatures of computer viruses and other undesirable software entities" (Col. 18, lines 17-20 – emphasis added). However, Kephart's disclosure of using a list of candidate signatures in the evaluation mode for both computer viruses and other undesirable software entities *teaches away* from applicant's claimed technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (emphasis added), as claimed, since the same evaluation mode in Kephart is used for both computer viruses and other undesirable software entities, without any indication of order.

Thus, there is absolutely no evidence in the Kephart reference that makes it clear that such missing descriptive matter is necessarily present in the Kephart system. In fact, there is even evidence to the contrary. In view of the arguments made hereinabove, any inherency argument has thus been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

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The foregoing anticipation criterion has simply not been met by the above reference. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 45, the Examiner has relied on Col. 5, lines 57-61 from the Kephart reference and an inherency argument to make a prior art showing of applicant's claimed technique "wherein the anti computer virus logic of a plurality of end users each includes a different selected set of computer programs banned from use."

Applicant respectfully asserts that the excerpt from Kephart relied upon by the Examiner to make the foregoing inherency argument merely discloses that "[i]n a first step, the user supplies either (a) a file containing a list of virus signatures to be evaluated or (b) one or more files, each containing one or more portions of invariant viral code from which one or more virus signatures are to be extracted" (emphasis added). The Examiner argued that "it is an inherent feature of Kephart that each end user anti computer virus logic includes a different selected set of computer programs (user-selected signatures) banned from use." Applicant respectfully disagrees, and asserts that Kephart merely discloses that the user supplies "one or more files, each containing one or more portions of invariant viral code." However, merely disclosing that the user may supply one or more files containing portions of invariant viral code fails to even suggest a technique "wherein the anti computer virus logic of a plurality of end users each includes a different selected set of computer programs banned from use" (emphasis added), as claimed by applicant.

Further, with respect to Claim 46, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Kephart in view of Golds et al. (U.S. Patent Publication 2001/0020245). Specifically, the Examiner relied on Paragraphs 0003, 0008, and 0031 in Golds to make a prior art showing of applicant's claimed technique "wherein an anti-virus scan is performed when a file access request is received, and if said anti-virus scan is not passed, an anti-virus action is triggered and a fail response is returned to an operating

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system, and if said anti-virus scan is passed, a scan for the computer programs banned from use is performed.”

Applicant respectfully asserts that the excerpt from Golds relied upon by the Examiner merely discloses that “[s]oftware modules such as file system filter drivers may be stacked or otherwise arranged linearly (e.g., chained), and perform their operations in the order in which they are stacked” (emphasis added). Additionally, Golds discloses that “the drivers can intercept IRPs [(I/O request packets)], and modify, return and/or cancel them” (emphasis added). However, the mere disclosure that file system filter drivers may be arranged linearly and that the drivers can intercept, modify, return, and/or cancel IRPs fails to even suggest a technique “wherein an anti-virus scan is performed when a file access request is received, and if said anti-virus scan is not passed, an anti-virus action is triggered and a fail response is returned to an operating system, and if said anti-virus scan is passed, a scan for the computer programs banned from use is performed” (emphasis added), as claimed by applicant. Clearly, the excerpts from Golds relied upon by the Examiner fail to even suggest that “if said anti-virus scan is passed, a scan for the computer programs banned from use is performed” (emphasis added), as claimed by applicant.

In addition, the Examiner argued that “it is inherent in Kephart that all signatures will be scanned and therefore, if one signature does not match a file, the next will be checked.” Applicant respectfully disagrees with the Examiner’s inherency arguments. Applicant respectfully asserts that arguments made hereinabove with respect to the independent claims adequately rebut the inherency arguments made by the Examiner for applicant’s claimed technique “wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use” (emphasis added), let alone where “if said anti-virus scan is passed, a scan for the computer programs banned from use is performed” (emphasis added), as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

To this end, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.